

REMARKS

Upon entry of the above claim amendments, claims 33-34, 36-39, 42, 44-45, 47-49, 53 and 58 will be pending in the present application. Claims 1-32, 35, 40-41, 43, 46-52, 54-57 and 59 have been cancelled. Claim 33 has been amended such that R² is an optionally halogen-substituted lower alkyl and CY is cyclopentane ring, cyclohexane ring, pyrrolidine ring, morpholine ring, piperazine ring, piperidine ring, benzene ring, dihydropyridine ring, pyridine ring, pyrazine ring, pyrimidine ring, pyrrole ring, pyrazole ring, imidazole ring, triazole ring, tetrazole ring, oxazole ring, oxadiazole ring, oxazolidine ring and thiazole ring. Support for the claim amendments can be found at page 16, lines 30-31 and page 18, lines 19-23. No new matter has been added.

Teleconference with Examiner

The Applicants thank the Examiner for her time during the teleconference. As suggested by the Examiner, the Applicants' claim amendments are specifically supported in the specification and are not a mix and match of various embodiments. Also, Applicants' claimed embodiments fall outside of the invention described in US Patent 7, 335,665, which was a concern of the Examiner.

However, Applicants maintain that they are still entitled to the priority date of February 10, 2003 and disagree with the Examiner that to be granted priority the priority document and the present application should be *verbatim* the same. Applicant respectfully requests that the Examiner reconsider in light of the comments below and grant Applicants the priority date of February 10, 2003.

Claim to the Benefit of Priority Date of JP2003-032123

On May 20, 2009, a certified translation of the foreign priority document, JP 2003-032123, of the present application was transmitted to the USPTO by Express Mail. Applicants respectfully maintain that such transmission perfects Applicants' claim to priority of February 10, 2003.

The Examiner has denied the Applicants priority claim on the basis that the two documents are not the same, since material has been added to the instant application. The priority document and the application that claims the benefit of the priority document do not have to be *verbatim* the same document. In order to claim priority Applicants must show where the claims of the later application are fully supported in the manner required by 35 U.S.C. § 112, first paragraph in the earlier filed priority application for which priority benefit is claimed. See *Ex Parte Nobuhiko Ota*, Toshikazu Hamao and Yoshifusa Tsubone, Appeal No. 2006-1736 (BPAI, September 29, 2006).

The first paragraph of 35 U.S.C. § 112 "requires a 'written description of the invention' which is separate and distinct from the enablement requirement." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555,

1563 (Fed. Cir. 1991). An adequate written description of a chemical invention “requires a precise definition, such as by structure, formula, chemical name, or physical properties.” *University of Rochester v. G.D. Searle & Co., Inc.*, 358 F.3d 916, 927 (Fed. Cir. 2004); *Regents of the Univ. of Cal. v. Eli Lilly & Co., Inc.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997); *Fiers v. Revel*, 984 F.2d 1164, 1171 (Fed. Cir. 1993). The first paragraph of § 112 does not require a description of the complete structure of every species within a chemical genus. *See Utter v. Hiraga*, 845 F.2d 993, 998 (Fed. Cir. 1988) (“A specification may, within the meaning of 35 U.S.C. § 112, ¶ 1, contain a written description of a broadly claimed invention without describing all species that claim encompasses.”). Rather, the written description requirement is satisfied when the specification “set[s] forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed.” *University of Rochester v. G.D. Searle & Co., Inc.* Possession of a genus “may be achieved by means of a recitation of a representative number of [compounds] ... falling within the scope of the genus.” *Eli Lilly*, 119 F.3d at 1569.

The currently pending claims are supported and enabled by the priority document as shown in the detailed table of Applicants' May 27, 2009 response. Additionally, the priority document recites and shows how to make a representative number of compounds of the claimed genus.

The Examiner pointed out that instant application includes 7 tables and 89 compounds wherein the priority document includes 5 tables and 83 compounds. Table 1 of the instant application describes IC50 values of the some of the claimed compounds. Tables 2-7 of the present application are the same as Tables 1-5 of the priority document with the inclusion of six additional compounds. Applicant believes that Tables 1-5 of the priority document include a sufficient representative number of compounds in light of the absence of the six compounds that were added to the PCT application.

Applicants urge the Examiner to review the priority document in light of the pending claims and grant priority back to Japanese Provisional JP 2003-032123.

35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 33, 34, 54-57 and 59 under 35 U.S.C. § 112, first paragraph. Claims 54-57 and 59 have been cancelled and claim 33 has been amended to include a subgenus of Cy which is supported in the present application at page 18, lines 19-23. Applicants believe that such amendments overcome the Examiner's rejection.

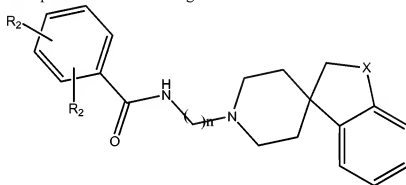
As discussed above, possession of a genus “may be achieved by means of a recitation of a representative number of [compounds] ... falling within the scope of the genus.” *Eli Lilly*, 119 F.3d at 1569. Applicants respectfully submit that how to make and use a representative number of compounds of the present claims is detailed in the specification with sufficient detail to enable one of ordinary skill

in the art to make and use the present invention, and respectfully request reconsideration and withdrawal of the rejection of Claims 33 and 34.

35 U.S.C. § 102(c)

Claims 33-44 and 53 were rejected under 35 U.S.C. § 102(c) as being anticipated by Marzabadi *et. al*, WO 2004/004714 ("Marzabadi"). Claims 35, 40-41 and 43 have been cancelled. Claim 33, from which 34, 36-39, 42, 44 and 53 depend, has been amended to recite R² is optionally halogen-substituted lower alkyl.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In order to anticipate the presently claimed embodiments Marzabadi must teach each and every element of the pending claims. Marzabadi describes compounds of the following formula:



wherein the nitrogen on the amide is only substituted with hydrogen. Marzabadi does not teach or suggest that the nitrogen is an optionally halogen-substituted lower alkyl. Thus, Marzabadi does not teach each and every element of the claimed embodiments and does not anticipate the claimed embodiments, since in the claimed embodiments R² is an optionally halogen-substituted lower alkyl.

Moreover, as put forth in Applicants response of May 27, 2009, Marzabadi's priority document, USSN 10/189,146, only discloses carbocyclic rings spiro to the piperidine and does not disclose any compounds wherein the atom corresponding to W³ of the presently claimed embodiments is oxygen. Thus, compounds with a spiro-furan ring were not contemplated in the Marzabadi priority document. The effective date of the Marzabadi WO 2004/004714 reference for any compounds with a spiro-isobenzofuran moiety is July 3, 2003, which is after the February 10, 2003, filing date of the present application.

In view of the amendments and the remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 33, 34, 36-39, 42, 44 and 53 as being unpatentable in view of Marzibaldi.

35 U.S.C. § 103(a)

Claims 33-44 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marzabadi. Claims 35, 40-41 and 43 have been cancelled. As discussed above, Marzabadi does not teach each and every element of the claimed embodiments and does not make the above-recited claims unpatentable under 35 USC § 103. Marzabadi does not suggest or motivate one skilled in the art to substitute the nitrogen on the amide in Marzabadi with an optionally halogen-substituted alkyl.

Additionally, as noted above, the effective date of the Marzabadi reference for any compounds with a spiro-isobenzofuran moiety is July 3, 2003, which is after the February 10, 2003, filing date of the present application. There is no teaching, suggestion, or motivation in the Marzabadi priority document to change the carbocyclic ring structure to the spiro-isobenzofuran and aza-spiroisobenzofuran ring systems where W³ is -O- of the presently-claimed invention.

In view of the amendments and remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 33, 34, 36-39, 42, 44 and 53, under 35 U.S.C. § 103(a) over Marzabadi.

35 U.S.C. § 102(g)

The Examiner rejected Claims 33-39, 42-44 and 53 under 35 U.S.C. § 102(g) as being anticipated by US 2006/0173027 now US Patent 7,335,665 to Marzabadi et al. ("the '665 patent").

As amended the currently claimed embodiments are not the same invention as that described and claimed in the '665 patent. The compounds of the '665 patent do not describe or suggest the compounds presently claims, specifically the nitrogen on the amide of the '665 patent is only substituted with hydrogen not an optionally-halogen substituted alkyl, wherein as recited in Claim 1, R² is optionally halogen-substituted lower alkyl. Thus, the invention described in the '665 patent does not include the claimed embodiments.

In view of the amendments and remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 33, 34, 36-39, 42, 44 and 53, under 35 U.S.C. § 102(g) as being anticipated by US 2006/0173027.

Conclusion

In light of the amendments and remarks above, Applicants believe that the present application is in condition for allowance.

Respectfully submitted,

By /Janet E. Fair, Reg. No. 56042/
Janet E. Fair, Reg. No. 56,042
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel: (732)594-4283

Date: September 29, 2009